REMARKS

Foreign Priority

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

Status Of Application

Claims 1-27 were pending in the application; the status of the claims is as follows:

Claims 1, 2, 6, 7, 20, and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,745,102 to Bloch et al. (hereinafter the "Bloch patent").

Claims 3-5, 8-10, and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and in view of U.S. Patent No. 5,731,861 to Hatano et al. (hereinafter the "Hatano patent").

Claims 11, 12, 25, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 1, 2, 6, 7, 20, and 21 above, and further in view of U.S. Patent No. 6,201,587 B1 to Sakamaki (hereinafter the "Sakamaki patent").

Claims 13, 14, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and the Sakamaki patent as applied to claims 11, 12, 25, and 26 above, and further in view of U.S. Patent No. 5,937,107 to Kazami et al. (hereinafter the "Kazami patent").

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 1, 2, 6, 7, 20, and 21 above, and further in view of U.S. Patent No. 5,887,198 to Houlberg et al. (hereinafter the "Houlberg patent").

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 11, 12, 25, and 26 above, and further in view of U.S. Patent No. 5,600,563 to Cannon et al. (hereinafter the "Cannon patent").

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and the Cannon patent as applied to claim 17 above, and further in view of U.S. Patent No. 4,200,390 to Tagashira et al. (hereinafter the "Tagashira patent").

Drawings

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

Specification Amendment

In the Preliminary Amdendment filed November 20, 2000, an erroneous instruction was provided to change "demodulating" to "light-adjusting" on Page 24, line 9 of the Specification (see page 4 of the Preliminary Amendment). This change should have been made on page 25, not page 24. The above amendment to the Specification is provided to correct this error.

Claim Amendments

Claims 1, 5, 6, 10, 12, 20, 24, 26 and 27 have been amended to more particularly point out and distinctly claim the invention. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

Rejections under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a)

Claims 1, 2, 6, 7, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Bloch patent. Claims 3-5, 8-10, and 22-24 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the Bloch patent and in view of the Hatano

patent. Claims 11, 12, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 1, 2, 6, 7, 20, and 21 above, and further in view of the Sakamaki patent. Claims 13, 14, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and the Sakamaki patent as applied to claims 11, 12, 25, and 26 above, and further in view of the Kazami patent. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 1, 2, 6, 7, 20, and 21 above, and further in view of the Houlberg patent. Claim 17 under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent as applied to claims 11, 12, 25, and 26 above, and further in view of the Cannon patent. Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and the Cannon patent as applied to claim 17 above, and further in view of the Tagashira patent. These rejections are respectfully traversed based on the following.

The Bloch patent shows an alphanumeric LCD display 122 integrated with a floppy disc 120. When the disc is inserted into the drive, a terminal strip 112 mates with connectors 212 in the drive. As files are written onto the floppy disc, the file names are stored in memory 114 for storage and display on the display. The Bloch patent does not show or suggest any display of information other than file names.

The Hatano patent describes a liquid crystal display material having a cholesteric phase at room temperature.

The Sakamaki patent shows a process for indexing video cassettes using a rewritable label on the cassettes. Video information stored on video cassette 1 is reproduced by videorecorder 201. During reproduction, the video information is captured and stored in the image memory 101 of indexing apparatus 10 (column 7, lines 52-64). When specific frame of the video information is selected, the reproduction is stopped and the video cassette is removed from the video cassette recorder and inserted in the indexing apparatus. The image data of one frame is read from image memory 101, processed by image processing circuit 102 and fed to drive circuit 103 (column 7, line 66 – column 8,

line 9). The drive circuit drives a print head 18 which applies appropriate signals to "print" the image data onto display portion 3 (column 8, lines 10-27).

The Kazami patent shows an apparatus for digitizing images from developed photographic film. Film forwarding control circuit 23 advances developed film 23 to be captured by CCD image formation circuit 24. The resulting images are stored in image memory 27. In one function, CPU 26 converts the images stored in image memory 27 into thumbnail images so that thumbnail images of all of the stored images may be displayed on display device 29. The Kazami patent does not provide any details on the display device 29.

The Houlberg patent shows a device for driving a PCMCIA memory card. It is stated that the device should include utilities for formatting the memory card (column 2, lines 18-21).

The Cannon patent shows a system for storing a plurality of greeting card descriptions, including images, on a CD-ROM 33 for distribution to card printing systems (Abstract).

The Tagashira patent shows a copier system where copy count setting dial 101 determines the number of copies to be made. The count down of producing those copies is displayed on display 132.

In contrast to the cited prior art, claim 1 includes:

> a driver which records the image data to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

The Office Action has combined the Bloch and Hatano patents with the Sakamaki and Kazami patents to provide an obviousness rejection. Applicants' respectfully disagree with this combination. The Bloch patent shows the use of a segment alphanumeric

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display. The Hatano patent shows a particular material used in LCD displays with no information on display configuration. There is no suggestion in these references that image data, such as provided in the Sakamaki and Kazami patents, can be successfully incorporated into a display device integrated with a storage medium. The Kazami patent provides no description of the display device used to display the thumbnail images. The Sakamaki patent teaches away from the combination by suggesting that providing an image to a display requires a separate apparatus (10) and the need to imprint images using a print head to apply spot-heating to the reversible display device 4 (column 3, lines 1-20, column 8, lines 10-27).

As stated in the MPEP at §2142 "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." The succeeding section (§2143) of the MPEP then explains the requirements of a *prima facie* case for obviousness:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

With regard to the second element of MPEP §2143, the rejection does not state a suggestion or motivation in the prior art to combine a graphical image with the teaching of the Bloch patent because the Bloch patent only is capable of displaying character information. Demonstrating that full scale display systems have used thumbnail images does not provide a motivation for modifying small scale systems with severe power and space constraints. Therefore, the burden of presenting a *prima facie* case for obviousness has not been met. The purpose of the suggestion requirement is to prevent hindsight analysis. "Our case law makes clear that the best defense against the subtle but powerful

attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak,* 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is clear from the rejection that the only suggestion to make the combination of the cited references comes from Applicant's written description. This is the essence of impermissible hindsight.

> "The result is that the claims were used as a frame, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. ... To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious affect of hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1552-3, 220 USPQ 303, 312-13 (Fed. Cir. 1983)

The second element of §2143 requires a reasonable expectation of success for the combination. MPEP §2143.02. However, the use of the segmented alphanumeric display 122 of the Bloch patent (column 4, lines 37-47) indicates that a graphical image display could not be effectively incorporated into the apparatus of the Bloch patent. If the structures taught in the references are incompatible, it cannot be said that there is a reasonable expectation that the combination of the teachings of the references will be successful. From the teachings of the three cited references, it is apparent that the structures disclosed therein are not compatible and there can be no reasonable expectation of success of the combination.

Therefore, the cited prior art does not comprise a *prima facie* case for obviousness and claim 1 is patentably distinct from the cited prior art. Claims 2 and 5 are dependent upon claim 1. If an independent claim is nonobvious, then claims that depend from that claim are also nonobvious. MPEP §2143.03. Therefore, claim 1, 2 and 5 are patentably distinct from the cited prior art.

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Also in contrast to the cited prior art, claim 6 includes,

> a driver which records the image data processed by the data processing section to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

As explained above with regard to claim 1, this combination of limitations is not suggested by the cited prior art. Therefore, claim 6 is patentably distinct from the cited prior art. Claims 7, 10, 12 and 14-19 are dependent upon claim 6. If an independent claim is nonobvious, then claims that depend from that claim are also nonobvious. Therefore, claim 6, 7, 10, 12 and 14-19 are patentably distinct from the cited prior art.

Also in contrast to the cited prior art, claim 20 includes,

> a storage medium which has a memory section to be stored with image data and a display section to display information and the image data; and

> ...

> a driver which records the image data processed by the data processing unit to the memory section of the storage medium and renews information and a display image on the display section of the storage medium in accordance with the image data.

As explained above with regard to claim 1, this combination of limitations is not suggested by the cited prior art. Therefore, claim 20 is patentably distinct from the cited prior art. Claims 21, 24, 26 and 27 are dependent upon claim 20. If an independent claim is nonobvious, then claims that depend from that claim are also nonobvious. Therefore, claim 20, 21, 24, 26 and 27 are patentably distinct from the cited prior art.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 5-7, 10, 12 and 14-21, 24, 26 and 27 under 35 U.S.C. § 102(b) as being anticipated by the Bloch patent or under 35 U.S.C. § 103(a) as being unpatentable over the Bloch patent and in view of the Hatano, Sakamaki, Kazami, Houlberg, Tagashira and Cannon patents, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

The following is a marked-up version of the changes to the specification and claims which are being made in the attached response to the Office Action dated June 5, 2002.

IN THE SPECIFICATION:

The paragraph beginning at page 25, line 3, and ending at page 25, line 12:

The light-adjusting circuit 304 controls the quantity of light emitted from the built-in flash 105 to emit a quantity of light which is predetermined by a central control section 211. In flash photography, simultaneously with a start of exposure, the sensor 305 starts receiving reflected light from an object irradiated by flash light, and when the quantity of light received by the sensor 305 reaches a specified value, a lighting stop signal is outputted from the [demodulating] light-adjusting circuit 304. A flash driving circuit 216 stops light emission of the built-in flash 105 in response to the lighting stop signal. Thus, the quantity of light emitted from the flash 105 is controlled.

IN THE CLAIMS:

1.   (Twice Amended) A driving device which accepts a storage medium comprising a memory section to be stored with image data and a display section to display information and [record] the image data to the memory section, said driving device comprising:

a receiving section where the storage medium can be set and ejected, the display section of the storage medium being hidden and not being viewable when the storage medium is set in the receiving section; and

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a driver which records the image data to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

2. (Twice Amended) A driving device according to claim 1, further comprising:

a power supply section which supplies electric power to the display section of the storage medium which is set in the receiving section so that the information and the display image on the display section can be renewed by the driver.

6. (Twice Amended) An information processing device which accepts a storage medium comprising a memory section to be stored with image data and a display section to display information and [record] the image data [to the memory section], said information processing device comprising:

a receiving section where the storage medium can be set and ejected, the display section of the storage medium being hidden and not being viewable when the storage medium is set in the receiving section;

a data processing section which processes the image data; and

a driver which records the image data processed by the data processing section to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

7. (Twice Amended) An information processing device according to claim 6, further comprising:

a power supply section which supplies electric power to the display section of the storage medium which is set in the receiving section so that the information and the display image on the display section can be renewed by the driver.

11. (Cancelled)

12.   (Twice Amended) An information processing device according to claim [11] 6, wherein the data processing section has an image pick-up unit which picks up an image of an object by use of an image sensor and produces the image data.

13.   (Twice Amended) An information processing device according to claim [11] 6, wherein the driver records the image data to the memory section and writes a thumbnail image of the image data as the display image on the display section.

14.   (Twice Amended) An information processing device according to claim 13, wherein the driver deletes the image data stored in the memory section and deletes [a] the thumbnail image of the deleted image data from [information on] the display section.

17.   (Twice Amended) An information processing device according to claim 6, [which] wherein the information processing device is a printer.

20.   (Twice Amended) An information processing system comprising:
a storage medium which has a memory section to be stored with image data and a display section to display information and the image data; and
an information processing device where the storage medium is set to be accessed by the information processing device and can be ejected, the display section of the storage medium being hidden and not being viewable while the storage medium is set in the information processing device;
wherein the information processing device comprises:
a data processing unit which processes the image data; and
a driver which records the image data processed by the data processing unit to the memory section of the storage medium and renews information and a display image on the display section of the storage medium in accordance with the image data.

21.   (Twice Amended) An information processing system according to claim 20, wherein the information processing device further comprises a power supply section which supplies electric power to the display section of the storage medium so that the driver can renew the information and the display image on the display section.

25.   (Cancelled)

26.   (Twice Amended) An information processing system according to claim [25] 20, wherein the information processing device comprises an image pick-up unit which picks up an image of an object by use of an image sensor and produces the image data.

27.   (Twice Amended) An information processing system according to claim [25] 20, wherein the driver records image data to the memory section and writes a thumbnail image of the image data as the display image on the display section.